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Docket No. 200209507-1

DEC 18 2006

Remarks

This communication is responsive to the Final Office Action of October 20, 2006. Reexamination and reconsideration of claims 1-16, 19-23, and 25-26 is respectfully requested.

Summary of The Office Action

Claims 1-5, 10, 12-13, 19-23 and 25-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Publication No. 56-113641.

Claims 10 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,877,234 (Mandel).

Claims 6, 11 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. 56-113641 as applied to claims 5, 10 and 13 above, and further in view of U.S. Patent No. 4,717,027 (Laure et al.).

Claim 9 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. 56-113641 as applied to claims 1 and 12 above, and further in view of Japanese Publication No. 61-124459.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. 56-113641 as applied to claim 12 above, and further in view of U.S. Patent No. 6,456,311 (Harush et al.).

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Examiner's Response to Arguments

The Final Office Action on page 11 includes the Examiner's "Response to Arguments." Applicant provides the following reply.

Independent Claim 1

With regard to independent claim 1, the Examiner maintains the §102 rejection and simply repeats the citation to Figures 1-5 and the Abstract of JP Publication No. 56-113641. No particular rebuttal was provided to Applicant's distinguishing arguments submitted in the previously filed response.

MPEP 2114 provides guidelines for determining a proper §102 rejection. Applicant respectfully submits that JP Publication No. 56-113641 fails to anticipate the claims based on MPEP 2114.

For example, MPEP 2114, third paragraph, states:

A PRIOR ART DEVICE CAN PERFORM ALL THE FUNCTIONS OF THE APPARATUS CLAIM AND STILL NOT ANTICIPATE THE CLAIM

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.
(MPEP 2114) [Emphasis added]

JP Publication No. 56-113641 has a structural difference from claim 1 and thus, based on this rule, does not support a proper anticipation rejection. As Applicant explained in the "Second Response" filed August 2, 2006, JP Publication No. 56-113641 includes a feeding mechanism 7 (Figure 3 and abstract) that creates a different structure than what is claimed. The feeding mechanism 7 holds the paper thereby taking control of paper movement (e.g. speed and direction) away from the carrying belts 5a, 5b. As such, the carrying belts 5a, 5b do not align the paper against the reference surface 6 and the mechanism is thus structurally different. Claim 1 recites that the plurality of media carriers being configured to move the print media ... to cause the print media to rotate

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towards and align against the registration wall. Since the feeding mechanism 7 is required in structure of the JP Publication, the structure is different.

Looking to another paragraph of MPEP 2114, the first paragraph states:

**APPARATUS CLAIMS MUST BE STRUCTURALLY
DISTINGUISHABLE FROM THE PRIOR ART**

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference)
(MPEP 2114)

For the same reasons as above, JP Publication No. 56-113641 requires a feeding mechanism 7, which is a structural difference from what is recited in claim 1. Therefore, claim 1 is not anticipated and the rejection should be withdrawn. The Office Action cannot ignore the actual structure of the JP Publication and cannot ignore the feeding mechanism 7 in an attempt to support a §102 rejection. Such a rejection cannot stand.

Independent Claim 10

The Examiner's Response begins at the bottom of page 11 of the Final Office Action. As with claim 1, no particular rebuttal was provided to Applicant's distinguishing arguments submitted in the previously filed response. The Examiner maintains the §102 rejection and repeats the citation to Figures 1-5 and the Abstract of JP Publication No. 56-113641. The feeding mechanism 7 was not addressed in the Final Office Action.

Based on the explanation above and reference to MPEP 2114, the JP Publication is structurally different due to the feeding mechanism 7. As such, the JP Publication fails to support a proper §102 rejection. Therefore, claim 10 is not anticipated and the §102 rejection should be withdrawn.

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Independent Claims 12 and 19

Claims 12 and 19 were also rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Publication No. 56-113641. Based on MPEP 2114, the JP Publication requires a feeding mechanism 7, which is a structural difference from the recited structure of claims 12 and 19. Thus, the §102 rejection is improper and should be withdrawn.

35 U.S.C. §102(b) Rejection Based on Mandel - U.S. Patent No. 4,877,234

Independent claims 10 and dependent claim 11 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,877,234 (Mandel).

The Examiner's Response simply maintained the rejection and cited Figure 1 of Mandel. The response did not address the Applicant's explanation that Mandel's scuffer roller 30 was a structural difference. Based on MPEP 2114, which states, "the prior art cannot anticipate the claim if there is any structural difference," Mandel's scuffer roller 30 is a structural difference. Therefore, Mandel fails to support a proper §102 rejection and the rejection should be withdrawn.

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Conclusion

For the reasons set forth above, claims 1-16, 19-23, and 25-26 patentably and unobviously distinguish over the references and are allowable. An early allowance of all claims is earnestly solicited.

Respectfully submitted,



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